

REMARKS

Status of the claims

Claim 1 is presently pending and stands rejected under 35 U.S.C. § 103(a).

35 U.S.C. § 103(a)

Claim 1 was rejected as allegedly obvious over Eisenberg *et al.* (U.S. Patent 6,453,242), in view of Barbas *et al.* (U.S. Patent No. 6,140,081), further in view of Case *et al.* (U.S. Patent No. 6,503,717).

As discussed in the interview and pointed out in the Response dated February 19, 2004, Eisenberg and Case are not available as references under 35 U.S.C. § 103(a) due to the provisions of 35 U.S.C. § 103(c).

35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The present application was filed on November 20, 2001, and is owned by Sangamo BioSciences, Inc. by virtue of an assignment recorded on February 4, 2002 at Reel 012363, Frame 0236.

Both Eisenberg *et al.* and Case *et al.* disclose subject matter developed by another, and both qualify as prior art under Section 102(e) (*i.e.*, by virtue of their filing dates). Moreover, both Eisenberg *et al.* and Case *et al.* are also owned by Sangamo BioSciences, Inc. Assignment of Eisenberg *et al.* to Sangamo BioSciences, Inc. was recorded on January 2, 2001 at Reel 011246, Frame 0574. Assignment of Case *et al.* to Sangamo BioSciences, Inc. was recorded on April 10, 2001 at Reel 011471, Frame 0650. Accordingly, both Eisenberg *et al.* and Case *et al.* fulfill all of the requirements of 35 U.S.C. § 103(c) and are therefore not available as references under 35 U.S.C. § 103(a).

The remaining reference (Barbas *et al.*) fails to disclose or suggest position-dependence of recognition of triplet sequences by zinc fingers in a multi-finger protein, as was discussed at the interview, and therefore fails to render the pending claim obvious.

CONCLUSION

Applicants thank Examiner Chakrabarti for participating in a personal interview on February 19, 2004. As a result of the interview, the response dated February 19, and the remarks presented herein, the undersigned believes that claim 1 is in condition for allowance.

Respectfully submitted,

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